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EXAMINER

DOLLINGER, MICHAEL M

ART UNIT

PAPER NUMBER

1766

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DELIVERY MODE

12/06/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Amendment

1. Applicants have amended claim 1 to more narrowly define monomers A1 to alpha,beta-unsaturated acids with 3 to 13 carbon atoms chosen from the group consisting of methacrylic acid, crotonic and isocrotonic acid, vinyl acetic acid, 3-propylacrylic acid and 2-octenoic acid. This amendment does not overcome the rejection of Staritzbichler in view of Tuemmler because Tuemmler discloses that suitable acid functional monomers A1 include acrylic and methacrylic acid, crotonic and isocrotonic acid, vinylacetic acid, 3-propylacrylic acid, and 2-octenoic acid [col 3 lines 16-19].
2. Applicants have also amended claim 1 to narrow the scope of mono and dibasic carboxylic acid B2 to having from four to forty carbon atoms and narrow the scope of alcohols B1 to dihydric aliphatic linear, branched or cyclic alcohols having from two to twenty carbon atoms. These amendments do not overcome the rejection of Staritzbichler in view of Tuemmler because Staritzbichler discloses that the polycarboxylic acids of B include adipic and sebacic acid; the monocarboxylic acids have 5 to 20 carbon atoms; and the polyols include mono-, di- and tri-ethylene glycol [page 1 paragraph 12].

Response to Arguments

3. Applicant's arguments filed 11/26/2010 have been fully considered but they are not persuasive.

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4. Applicants argue that one having ordinary skill in the art would not have replaced the acid polymer A of Staritzbichler with the acid polymer A Tuemmler because the polymer A of Tuemmler is designed to react with a polymer B that is a ketone or aldehyde resin whereas the acid polymer A of Staritzbichler is designed to react with a polyester B. Applicants argue that the hydroxyl group containing polyesters B of the present invention do not have anything in common with the ketone or aldehyde resins B of Tuemmler. Applicants argue that Examiner is merely combining prior art elements without any objective reason to do so and is henceforth using hindsight from applicants' invention. This argument is not convincing. The composition of Staritzbichler discloses an acid functional polymer A in combination polyesters B and optionally component C which includes formaldehyde condensates of melamine and urea [page 2 paragraph 2]. So Staritzbichler can be considered the same type of composition of Tuemmler with an additional polyester component and one having ordinary skill in the art would consider some of their components interchangeable and analogous art. Examiner has also provided motivation for using the polymer A of Tuemmler: One would have been motivated to use the preferred polycarboxylic polymer A from Tuemmler as the polycarboxylic acid polymer A of Staritzbichler because Tuemmler teaches that the polycarboxylic acid A features a high pigment binding capacity, is stable on storage, and undergoes little or no change in viscosity in the course of storage in the pigment pastes produced therefrom. Examiner does not need to rely on hindsight when the prior art gives clear motivation to combine the prior art references and arrive at the instantly claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MIKE DOLLINGER whose telephone number is (571)270-5464. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/mmd/

/David Buttner/
Primary Examiner, Art Unit 1765